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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,516	10/07/2003	Michael G. Bradley	5997.0024-01	8424
22852	7590	12/26/2008	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			VIG, NAresh	
		ART UNIT	PAPER NUMBER	
		3629		
		MAIL DATE		DELIVERY MODE
		12/26/2008		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/679,516	BRADLEY ET AL.	
	Examiner	Art Unit	
	NARESH VIG	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 November 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 10-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20081114</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This is in reference to communication received 14 November 2008. 1 – 7 and 10 – 17 are pending for examination.

Priority

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/094,806 & 60/311,125 and , fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Prior-filed application does not disclose

providing an indication of a likelihood that an appraisal value for a property, which is secured by a mortgage loan, was faulty;

receiving a past date;

receiving information representative of at least one of a borrower of the mortgage loan secured by the property, a property, or one or more demographics of the property location, such that the received information corresponds to the past date;

receiving the appraisal value based on the date; and

determining a score based on the received information, received appraisal, and the model, such that the score provides the indication of the likelihood that the appraisal value was faulty on the date

The considered priority date for the instant application is 07 October 2003 (filing date of the instant application).

Response to Arguments

Applicant's arguments and concerns are for amended claims which have been responded to in response to the pending claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 7 and 10 – 17 are not patentable because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, A "process" under § 101 must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)

matter (such as an article or materials) to a different state or thing or (3) the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.² If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to nonstatutory subject matter. Moreover, the recitation of “computer implemented” in the preamble with the absence of a computer in the body of the claim or a lack of “another statutory class” in the body of the claim does not make the claim statutory.

Also, as currently claimed, when only a past date and the appraisal value based on the past date is received, determining a score based on the received information only will be a subjective value.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 – 7 and 10 – 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in

² *The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. Gottschalk v. Aerson, 409 U.S. 63, 71 (1972), In re Bilski, Fed. Cir. 2007-1130*

the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As currently claimed by the applicant as their claimed invention, disclosure originally filed 07 October does not teach how one of ordinary skill in the art can use the invention for providing, based on a model, an indication of a likelihood that an appraisal value for a property, which is secured by a mortgage loan, was faulty by just using a past date and the appraisal value as of that past date without some other data to make the comparison and making the determination based on the comparison.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 7 and 10 – 17 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims the limitation:

As currently claimed, when a past date of a appraisal, and the valued of a appraisal as of that past date is received, it is not clear how the determination of the score is made based on the received information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 7 and 10 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradley et al. US Patent 7,289,965 in view of screen snapshots of Realtor Workstation hereinafter known as RWS and LeClerc et al. US Patent 6,834,120.

Regarding claims 1 and 12 – 15, as best understood by examiner, Bradley teaches system and method for providing, based on a model (computer program), an indication of a likelihood that an appraisal value for a property, which is secured by a mortgage loan, is faulty. Bradley teaches:

receiving information representative of at least one of a borrower, a property, or one or more demographics, such that the received information corresponds to the date determining a score based on the received information, received appraisal, and the model, such that the score provides the indication of the likelihood that the appraisal value is faulty

Bradley does not teach receiving a past date and receiving information representative of at least a property such that received information corresponds to the date. **Also, concept of determining of likelihood that data as of a specific date is**

faulty is an old an known concept, for example, to minimize fraud in subsidized food programs in schools, schools are known to check parent/guardian stated income by income of the parent/borrower from some other source to determine the likelihood that the information provided by the parent/guardian is faulty.

However, RWS teaches capability for receiving a past date and receiving information representative of at least a property such that received information corresponds to the past date [RWS, page 4, 12, 19, 44]..

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Bradley by adopting teachings of RWS to be able to access archived information,

Bradley in view of RWS does not specifically teach determining a score based on the received information, with the indication of the likelihood that the appraisal value (received information) was faulty on the date. However, LeClerc teaches system and method for measuring the accuracy by comparing the outputs different sources against each other [LeClerc, abstract]. Also, LeClerc teaches generating code [LeClerc, claim 3].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Bradley in view of TWS by adopting teachings of LeClerc to determine how well an appraiser has generated an appraisal of the property

Bradley in view of RWS and LeClerc teaches capability for providing, based on a model (computer program), an indication of a likelihood that an appraisal value for a property, which is secured by a mortgage loan, was faulty, by:

user interface which can be web based interface receiving a past date; receiving information representative of at least one of a borrower of the mortgage loan secured by the property, the property, or one or more demographics of a property location, such that the received information corresponds to the past date; receiving the appraisal value based on the past date; and determining a score based on the received information, the received appraisal, and the model, such that the score provides the indication of the likelihood that the appraisal value was faulty on the past date.

Regarding claim 2, Bradley in view of RWS and LeClerc teaches capability wherein the past date can be based on the closing date of the mortgage loan.

Regarding claim 3, Bradley in view of RWS and LeClerc teaches capability wherein the past date can be specified by a financial entity.

Regarding claim 4, Bradley in view of RWS and LeClerc teaches capability for maintaining, by the financial entity, the information representative of the borrower for determining the score (RWS teaches concept wherein an entity maintains information related to value of property).

Regarding claim 5, Bradley in view of RWS and LeClerc teaches capability wherein a user like financial entity can a lender.

Regarding claim 6, Bradley in view of RWS and LeClerc teaches capability wherein user like financial entity can be a broker.

Regarding claim 7, Bradley in view of RWS and LeClerc teaches capability for receiving information representative of the borrower's credit history as of the date.

Regarding claim 10, Bradley in view of RWS and LeClerc teaches capability for determining the appraisal value, such that the appraisal value corresponds to an estimate of value of the property as of the past date specified by the lender (RWS teaches capability for extracting data for specific date).

Regarding claim 11, Bradley in view of RWS and LeClerc teaches capability for determining the score based on a past date.

Regarding claim 16, Bradley in view of RWS and LeClerc teaches concept for means with capability for providing the appraisal value.

Regarding claim 17, Bradley in view of RWS and LeClerc teaches concept for a web browser means for providing information to an entity over the Internet.

Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 22, 2008

/Naresh Vig/
Primary Examiner, Art Unit 3629